



CASE LD0210 (NP) 10/29/03

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October 1, 2003

Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Art Unit: 1617

SALVATI ET AL.

Examiner: Shengjun Wang

APPLICATION NO: 10/075,870

FILED: FEBRUARY 14, 2002

FOR: FUSED CYCLIC SUCCINIMIDE COMPOUNDS AND ANALOGS
THEREOF, MODULATORS OF NUCLEAR HORMONE
RECEPTOR FUNCTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This is in response to the Restriction Requirement mailed July 1, 2003, a response to which was due August 1, 2003. A petition for a two-month extension of time is submitted herewith, thus extending the time for a response until October 1, 2003.

In the Office Action, the Examiner has made the following restriction:

- I. Claim 1, "drawn to pharmaceutical composition," classified in class 514, subclass 359+.
- II. Claims 2-4, drawn to "a method of treating various diseases employ[ing] the composition as defined in group I," classified in class 514, subclass 359+.

The Examiner states that the "inventions [of] group I and group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be

shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.5(h)). In the instant case the process as claimed can be used to make a materially different product such as Nuclear hormone receptor-interacting polypeptides."

The Examiner also states that "Claims 1 to 4 are generic to a plurality of disclosed patentably distinct species comprising: (a) various compounds as the therapeutical agents; and (if applicant elect[s] group II, claims 2 to 4), various diseases treated by the method. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, from each of the groups (if applicable), even though this requirement is traversed."

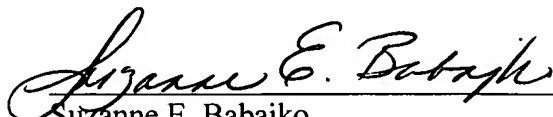
Applicants provisionally elect, with traverse, Group II, claims 2 to 4. Traversal is on the basis that a search encompassing the scope of all of the present claims would not present a serious burden (MPEP §803); both Groups I and II (the latter of which applicants note includes methods of treatment/modulation) are classified in class 514, subclass 359+. Applicants therefore respectfully request that the restriction requirement be reconsidered and withdrawn and that claims 1 to 4 be examined herein.

The Office Action also requires election of a single compound species. Applicants provisionally elect, with traverse, the compound of Example 58 (see page 113 (Table 1) and lines 5 to 7 on page 296 (claim 4)); and the disease "prostate cancer" (see line 6 on page 295 (claim 3)).

Should the Examiner have any questions or comments concerning this matter, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number set forth below.

Respectfully submitted,

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Date: *October 1, 2003*